

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Scott C. Harris	Group Art Unit 3662
Appl. No.	:	10/065,120	
Filed	:	September 18, 2002	
For	:	POSITION PRIVACY IN AN ELECTRONIC DEVICE	
Examiner	:	G. Issing	

Reply Brief

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant herewith files this reply brief under 41 CFR 41, this reply brief being directed only to the new points of argument in the Examiner's answer.

A request for oral hearing is also concurrently filed.

On page 5 of the appeal brief, the rejection refers to Zellner, and admits that an override control that operates in response to a manual press is not disclosed. However, the new point of argument for this subject matter begins at page 5, last paragraph, which alleges, without factual or legal support or basis, that it would have been obvious to use a menu selection of yes no or activate/deactivate as the single selection or a graphical user interface with a single graphical element.

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With all due respect, this is based entirely on hindsight. The statement that this "obviously" meets the manual actuation is not supported by the evidence in the case. Moreover, the statement in the first three lines of page 6, (analogizing this to the holding of an asterisk on a conventional phone enabling manner mode), with all due respect, is not supported by any evidence. The undersigned knows of no telephone in which the holding of an asterisk enables manner mode, and which enjoys a filing date which is sufficient to qualify itself as prior art against this case. Moreover, this statement and these arguments are tantamount to an admission that the subject matter is very different than the scope and contents of the prior art, but this is improperly attempting to reject the claim based on today's knowledge in the art, not based on the prior art.

Moreover, these rejections over Zellner ignore an important claim limitation of claim 1. Specifically, claim 1 requires that the override control "prevents said position detection module from determining its position". As explained on page 9 of the main appeal brief, Zellner's teaching as a whole does not suggest this specific limitation. Zellner as a whole would suggest removing a location that is produced, which is very different than preventing it from being produced in the first place.

Another new point of argument begins at the bottom of page 7, somehow suggesting that it would be obvious to modify Lemelson's PIN number to include a single dedicated button instead. The rejection alleges that there is "nothing to negate the use of a single number..." at the top of page 8. However, this completely ignores the overall teaching of Lemelson. Lemelson requires a PIN number to identify the actual owner. Removing that PIN number, and using a single button would eliminate Lemelson's stated function of identifying the real owner. This is hindsight. Moreover, *8 for manner mode or the single number for speed dialing is not supported by prior art

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in the case, and very likely does not have an early enough date to qualify as prior art in this case. Either way, making this modification would contradict Lemelson's stated purpose of attempting to identify a lawful owner.

On page 8, the new points of argument state and discuss Zellner's column 6 lines 18-42. Admittedly, these discuss some embodiments which describe disabling the handheld location system. While Zellner does use the word "disabling", Zellner does not teach or suggest the subject matter of claim 1 which requires that the position module is prevented from determining its position. as explained previously, Zellner teaches that dummy information be substituted. The clear implication of this is that information is being obtained by the location block device. While Zellner does use the word disable, he uses it only in the context of putting separate information in place of the device. Nowhere does Zellner teach or suggest preventing the device from obtaining the information in the first place. In fact, reading the above-cited paragraph as a whole would not suggest to one of ordinary skill in the art that Zellner prevents the device from obtaining its information in the first place. The word "disables" may have many different meanings. In context, the word "disable" does not refer to preventing the device from determining its position. It may simply mean preventing the output of the device from being coupled to the proper location. Only with benefit of the hindsight obtained from the teaching of the present application would one think that the word "disable" means preventing the device from obtaining its position. Zellner never says this.

The importance of this distinction should not be overlooked. If the device is actually prevented from determining its position, the position cannot be surreptitiously obtained from that device since it has never been obtained in the first place . Zellner

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does not make it clear that the device should be prevented from determining its position. Rather, one might speculate about what the embodiments described in the cited paragraph mean. However, there is no clear teaching of preventing a part from detecting its position as required by claims 1, 11 and 22.

The statement at the bottom of page 9 that not all claims have the scope is certainly correct, other claims have been urged for patentability for other reasons.

The next new point of argument is regarding the single key versus a sequence of keys. The argument on page 9 which states that an entry of a specified sequence of keys is not much more complicated than hitting a single key is respectfully suggested to be factually incorrect. Consider the example set forth in the reply brief of *8 for a nonemergency situation. A user would need to take out their phone, and find the * key and find the 8 key. This may be difficult to do in certain situations-e.g. in low lighting situations, or in other situations where the user is perhaps disoriented or not paying attention. Hitting a single key, on the other hand, is much easier. The key can be in a place where the user recognizes it, or the like. It can be on the edge of the phone or somewhere easy to find . Certainly, it defies logic to contend that entering a specified sequence of buttons such as star eight is not "much more complicated" than entering a single button press as required by the claims.

On page 10, the last full paragraph which starts with "regarding the combination" with all due respect this new point of argument is legally incorrect. The rejection attempts to argue that it is somehow possible to pick and choose parts of one reference and parts of another, while ignoring the other parts. This is legally incorrect. According to federal circuit law, the references as a whole must be combined.

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Interconnect Planning Corp. v. Feil, 774 F.2d 1132 (Fed Cir, 1985), for example, states the law that "Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution." Id at 1142.

In that case, "[T]he claims were used as a frame, and individual, naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention." This was found to be improper by the Federal Circuit.

It is not proper to "merely integrate the teachings of power conservation as taught by Siebel" as suggested by the rejection. The entire argument spanning pages 10-11 is legally incorrect.

The argument spanning pages 11-12 about how an emergency acquisition of almanac/ephemeris data could be used in Seiple is based entirely on hindsight. The simple fact remains: Seiple is an emergency detecting system, and would not be expected to turn off its position detecting system in a way that impairs its function as an emergency device. This is quite simply contrary to Seiple's teaching that it is an emergency detection system for use in an emergency. A person having ordinary skill in the art consulting Sieple as a whole would not be expected to make this modification. The incentive for making this modification, in contrast, is obtained from the present specification and claims.

With all due respect, the points of argument, cited above, are legally incorrect.

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Respectfully submitted,

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